Remarks

Claims 19 and 145-156 are pending.

Claims 19, 145-152 have been rejected on the grounds of Non-Statutory Obviousness-Type Double Patenting over the claims 1-4 of U.S. Patent Number 6,103,740 ('740).

Claims 19, 145-152 have been rejected on the grounds of Non-Statutory Obviousness-Type Double Patenting over the claims 1-4 of U.S. Patent Number 6,008,232 ('232).

Claims 19, 145-152 have been rejected on the grounds of Non-Statutory Obviousness-Type Double Patenting over the claims 1-6 and 11 of U.S. Patent Number 5,610,168 ('168).

Claims 19, 145-156 have been rejected on the grounds of Non-Statutory Obviousness-Type Double Patenting over the claims 1-3, 5-7 and 12 of U.S. Patent Number 5,478,847 ('847).

Obviousness-Type Double Patenting Rejections

U.S. 6,103,740

Claims 19, 145-152 have been rejected on the grounds of Non-Statutory Obviousness-Type Double Patenting over the claims 1-4 of '740. Applicants respectfully traverse that the patients treated by the practice of the presently claimed method would be the same patient group as those treated by the practice of the claimed method in '740 (that is, a method of lowering platelet count). Applicants respectfully traverse that the patients treated by the practice of the presently claimed method would inherently result by the practice of the patients being treated by the claimed method of '740.

The examiner states

> [a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the active method step of the '740 patent claims comprises administration of raloxifene hydrochloride (claim 2) to a post-menopausal woman (claim 3) via oral administration of 60 mg/day (claim 4). Accordingly, the instantly claimed effects of such administration (i.e., reducing the likelihood of incurring or developing estrogen-dependent breast cancer) would inherently result from the practice of the '740 patent method claims.

U.S. 6,103,740 is directed to a method of lowering platelet count in a post-menopausal woman comprising administration of 60 mg/day to a post-menopausal woman **in need thereof** an effective amount of raloxifene HCl. (emphasis added). Claim 145 of the instant application is directed to a method for reducing the likelihood of incurring or developing estrogen-dependent breast cancer which comprises administering orally to a post-menopausal woman **diagnosed as**

being in need of such therapy a once daily dose of a pharmaceutical composition comprising 60 mg of raloxifene HCl. (emphasis added). U.S. 6,103,740 is directed to a method for lowering platelet count in a post-menopausal woman in need thereof, and there is no teaching to diagnose or screen patients for reducing the likelihood of incurring or developing estrogen-dependent breast cancer. Applicants respectfully submit there is no teaching and no expectation in '740 that women, who are so diagnosed as being in need of such reduction of the likelihood of incurring or developing estrogen-dependent breast cancer, represent all postmenopausal women. Applicants respectfully submit there is no teaching and no expectation in '740 that women, who are so diagnosed as being in need of such lowering of platelet count, represent all postmenopausal women. Further, Applicants respectfully submit there is no teaching and no expectation in '740 that women, who are so diagnosed as being in need of such reduction of the likelihood of incurring or developing estrogen-dependent breast cancer, represent all postmenopausal women diagnosed in need of lowering platelet count.

U.S. 6,008,232

Claims 19, 145-152 have been rejected on the grounds of Non-Statutory Obviousness-Type Double Patenting over the claims 1-4 of '232. Applicants respectfully traverse that the patients treated by the practice of the presently claimed method would be the same patient group as those treated by the practice of the claimed method in '232 (that is, a method of preventing headaches). Applicants respectfully traverse that the patients treated by the practice of the presently claimed method would inherently result by the practice of the patients being treated by the claimed method of '232.

The examiner states

> [a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the active method step of the '232 patent claims comprises administration of raloxifene hydrochloride (claim 2) to a post-menopausal woman (claim 3) via oral administration of 60 mg/day (claim 4). Accordingly, the instantly claimed effects of such administration (i.e., reducing the likelihood of incurring or developing estrogen-dependent breast cancer) would inherently result from the practice of the '232 patent method claims.

U.S. 6,008,232 is directed to a method of preventing headaches in a post-menopausal woman comprising administration of 60 mg/day to a post-menopausal woman **in need thereof** an effective amount of raloxifene HCl. (emphasis added). Claim 145 of the instant application is directed to a method for reducing the likelihood of incurring or developing estrogen-dependent

breast cancer which comprises administering orally to a post-menopausal woman **diagnosed as being in need of such therapy** a once daily dose of a pharmaceutical composition comprising 60 mg of raloxifene HCl. (emphasis added). U.S. 6,008,232 is directed to a method of preventing headaches in a post-menopausal woman in need thereof, and there is no teaching to diagnose or screen patients for reducing the likelihood of incurring or developing estrogen-dependent breast cancer. Applicants respectfully submit there is no teaching and no expectation in '232 that women, who are so diagnosed as being in need of such reduction of the likelihood of incurring or developing estrogen-dependent breast cancer, represent all postmenopausal women. Applicants respectfully submit there is no teaching and no expectation in '232 that women, who are so diagnosed as being in need of preventing headaches, represent all postmenopausal women. Further, Applicants respectfully submit there is no teaching and no expectation in '232 that women, who are so diagnosed as being in need of such reduction of the likelihood of incurring or developing estrogen-dependent breast cancer, represent all postmenopausal women diagnosed in need of preventing headaches.

U.S. 5,610,168

Claims 19, 145-152 have been rejected on the grounds of Non-Statutory Obviousness-Type Double Patenting over the claims 1-6 and 11 of '168. Applicants respectfully traverse that the patients treated by the practice of the presently claimed method would be the same patient group as those treated by the practice of the claimed method in '168 (that is, a method of lowering serum cholesterol). Applicants respectfully traverse that the patients treated by the practice of the presently claimed method would inherently result by the practice of the patients being treated by the claimed method of '168.

The examiner states

> [a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the active method step of the '168 patent claims comprises administration of raloxifene hydrochloride (claim 11) to a post-menopausal woman (claim 4) via administration of 60 mg/day (claim 6). Accordingly, the instantly claimed effects of such administration (i.e., reducing the likelihood of incurring or developing estrogen-dependent breast cancer) would inherently result from the practice of the '168 patent method claims.

U.S. 5,610,168 is directed to a method of lowering serum cholesterol levels in a post-menopausal female comprising administration of 60 mg/day to a post-menopausal female **in need thereof** an effective amount of raloxifene HCl. (emphasis added). Claim 145 of the instant

application is directed to a method for reducing the likelihood of incurring or developing estrogen-dependent breast cancer which comprises administering orally to a post-menopausal woman **diagnosed as being in need of such therapy** a once daily dose of a pharmaceutical composition comprising 60 mg of raloxifene HCl. (emphasis added). U.S. 5,610,168 is directed to a method for lowering serum cholesterol levels in a post-menopausal woman in need thereof, and there is no teaching to diagnose or screen patients for reducing the likelihood of incurring or developing estrogen-dependent breast cancer. Applicants respectfully submit there is no teaching and no expectation in '168 that women, who are so diagnosed as being in need of such reduction of the likelihood of incurring or developing estrogen-dependent breast cancer, represent all postmenopausal women. Applicants respectfully submit there is no teaching and no expectation in '168 that women, who are so diagnosed as being in need of such lowering of serum cholesterol, represent all postmenopausal women. Further, Applicants respectfully submit there is no teaching and no expectation in '168 that women, who are so diagnosed as being in need of such reduction of the likelihood of incurring or developing estrogen-dependent breast cancer, represent all postmenopausal women diagnosed in need of lowering serum cholesterol.

In column 5, line 65 to column 6, line 2, there is discussion that raloxifene HCl was clinically tested for the treatment of breast cancer. Applicants refer to their June 10, 2009 response to an office action where there was discussion of the reference Buzdar "Phase II Evaluation of Ly156758 in Metastatic Breast Cancer" (listed in the 1449 form). LY156758 is raloxifene HCl. Applicants restate a portion of that response:

> For raloxifene HCl, Buzdar reported in the Abstract that "[t]here were no complete or partial responses and 1 patient showed a minor response," and that "[t]hese data illustrate that [raloxifene HCl] did not have significant antitumor activity in patients previously treated with tamoxifen therapy." (emphasis added). The authors concluded by stating that "[raloxifene HCl] did not show any antitumor activity in this study and no further evaluation of this drug is recommended." (emphasis added).
>
> One of ordinary skill in the art would not be provided with a reasonable expectation that raloxifene HCl would be effective to prevent breast cancer after reading Buzdar. One of ordinary skill in the art would not be provided with a reasonable expectation that raloxifene HCl would be effective to prevent breast cancer in a daily dosage range of 55-65 mg or 60 mg.

Applicants respectfully submit there is no teaching and no expectation in '168 that raloxifene HCl would be effective to prevent breast cancer in post-menopausal women at a daily dose of 60 mg. In particular, one of ordinary skill in the art, after reading Buzdar, would not be

provided with a reasonable expectation that a daily dose of 60 mg of raloxifene HCl would be effective to prevent breast cancer.

U.S. 5,478,847

Claims 19, 145-156 have been rejected on the grounds of Non-Statutory Obviousness-Type Double Patenting over the claims 1-3, 5-7 and 12 of '847 (which has been reissued as RE 39,050). Applicants respectfully traverse that the patients treated by the practice of the presently claimed method would be the same patient group as those treated by the practice of the claimed method in '847 (that is, a method of inhibiting bone loss or bone resorption). Applicants respectfully traverse that the patients treated by the practice of the presently claimed method would inherently result by the practice of the patients being treated by the claimed method of '847.

The examiner states

> [a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the active method step of the '847 patent claims comprises administration of raloxifene hydrochloride (claim 12) to a human diagnosed with osteoporosis (claim 2), to a post-menopausal woman (claim 3), via administration of 60 mg/day (claim 7), and wherein the raloxifene is administered prophylactically (claim 5). Accordingly, the instantly claimed effects of such administration (i.e., reducing the likelihood of incurring or developing estrogen-dependent breast cancer) would inherently result from administration of 60 mg/day of raloxifene hydrochloride to a post-menopausal woman having osteoporosis as claimed in the '847 patent.

U.S. 5,478,847 is directed to a method of inhibiting bone loss or bone resorption comprising administration of 60 mg/day to a post-menopausal female **in need thereof** raloxifene HCl. (emphasis added). Claim 145 of the instant application is directed to a method for reducing the likelihood of incurring or developing estrogen-dependent breast cancer which comprises administering orally to a post-menopausal woman **diagnosed as being in need of such therapy** a once daily dose of a pharmaceutical composition comprising 60 mg of raloxifene HCl. (emphasis added). U.S. 5,478,847 is directed to a method for inhibiting bone loss or bone resorption in a post-menopausal woman in need thereof, and there is no teaching to diagnose or screen patients for reducing the likelihood of incurring or developing estrogen-dependent breast cancer. Applicants respectfully submit there is no teaching and no expectation in '847 that women, who are so diagnosed as being in need of such reduction of the likelihood of incurring or developing estrogen-dependent breast cancer, represent all postmenopausal women. Applicants respectfully

submit there is no teaching and no expectation in '847 that women, who are so diagnosed as being in need of such inhibiting bone loss or bone resorption, represent all postmenopausal women. Further, Applicants respectfully submit there is no teaching and no expectation in '847 that women, who are so diagnosed as being in need of such reduction of the likelihood of incurring or developing estrogen-dependent breast cancer, represent all postmenopausal women diagnosed in need of inhibiting bone loss or bone resorption.

As stated in the argument for '168 rejection above, there is discussion that raloxifene HCl was clinically tested for the treatment of breast cancer. Applicants, therefore, incorporate by reference the discussion above for the response to the rejection over '168 and again state that there is no discussion in '168 or '847 about diagnosing or screening patients, who are to be administered raloxifene for inhibiting bone loss or bone resorption or for lowering serum cholesterol levels, for reducing the likelihood of incurring or developing estrogen-dependent breast cancer.

U.S. 6,103,740 was filed on August 4, 1998, issued on August 15, 2000, and has expired due to nonpayment of the maintenance fee (status date of January 28, 2008 in PAIRS). If all the maintenance fees for '740 had been paid, the expiration date would have been August 4, 2018.

U.S. 6,008,232 was filed on August 4, 1998, issued on December 28, 1999, and has expired due to nonpayment of the maintenance fee (status date of September 15, 2008 in PAIRS). If all the maintenance fees for '232 had been paid, the expiration date would have been August 4, 2018.

The present application is a continuation application with an effective filing date of Oct 29, 1997. The PCT application published as WO98/18449 on May 7, 1998 which is prior to the filing of either '740 or '232.

Further, as discussed above, Applicants maintain that no terminal disclaimer is appropriate or necessary; however, it is particularly inappropriate to reject the present application for obviousness-type double patenting when the patent cited in the rejection is later filed and results in a later expiration date than the application being rejected and where, if one were to file a terminal disclaimer to obviate such a rejection, there would be no term to disclaim beyond the cited patent because the cited patent expires later than the rejected patent. If anything, the present application is prior art to '740 or '232.

As a reminder, Applicants have filed terminal disclaimers to U.S. 6,303,634 and to U.S. 6,458,811. In a decision by the United States Court of Appeals for the Federal Circuit (submitted along with this response in an IDS), the court affirmed that U.S. 6,458,811 is invalid.

Applicants submit claims 19 and 145-152 are in condition for grant.

Respectfully submitted,

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